



Amendment A
Inventor: Daniel R. McClellan
Attorney Docket No.: 15215.2

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REMARKS

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE".

The claims stand variously rejected under 35 U.S.C. §102(b), 35 U.S.C. §103(a) and 35 U.S.C. §112, second paragraph, and one claim has been objected to for having redundant use of "comprising" in the preamble. It is submitted that the following comments and amendments clearly distinguish the invention from the cited references and it is respectfully requested that the remarks and amendments be considered and the rejections withdrawn. It is respectfully submitted that the rejections, under 35 U.S.C. §103(a) are not in compliance with the law relating to obviousness rejections and therefore must fail. It is respectfully requested that the Patent Office fulfill its burden as discussed in the following section on law.

A finding of obviousness must be based on four underlying factual determinations:

1. The scope and content of the prior art;
2. The differences between the prior art and the claimed invention;
3. The level of ordinary skill in the art; and
4. Objective considerations of non-obviousness such as commercial success, long felt but unmet need, failure of others to make the invention, and the like.

See *Graham v. John Deere Co.*, 148 U.S.P.Q. 459 (St. Ct. 1966). Failure to make these determinations precludes the making of a prima facie case of obviousness.

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The Patent Office must make the necessary findings and provide an administrative record showing the evidence on which its findings are based and its reasoning in reaching its conclusion. See *In Re Zurko* 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001). When patentability turns on the question of obviousness, the search for and analysis of the prior art must include evidence relevant to the finding of whether there is a teaching, motivation or suggestion to select and combine the references relied on as evidence of obviousness. See *In Re Sang Su Lee* _____ U.S.P.Q.2d _____ (Fed. Cir. 2002) (00-1158) citing *McGinley v. Franklin Sports, Inc.*, 60 U.S.P.Q.2d 1001; 1008 (Fed. Cir. 2001). There must be a reason to combine the references. The reason to combine references must be based on objective evidence of record. A showing of a suggestion, teaching or motivation to combine the prior art references is an essential component of an obviousness holding. *C. R. Bard, Inc. v. M3 Systems, Inc.*, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998).

Particular findings must be made as to the reason why a skilled artisan with no knowledge of the claimed invention would have selected the components for combination in the manner claimed. *In Re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). The Patent Office must identify specifically the principal, known to one of ordinary skill, that suggests the claimed combination. *In Re Rouffet*, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998). The Patent Office must explain the reasons why one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. Further, the Patent Office can satisfy the burden of showing obviousness of the combination only by showing some

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objective teaching in the prior art or that knowledge generally available to one of ordinary skill would lead that individual to combine the relevant teachings of the references. See *In Re Fritch*, 23 U.S.P.Q. 1780, 1783 (Fed. Cir. 1992). The factual question of motivation is material to ^{correct} patentability and cannot be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references simply to "use that which the inventor taught against the teacher". *W. L. Gore v. Garloch, Inc.*, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983). The Patent Office must examine the relevant data and articulate a satisfactory explanation for its action or position including a rational connection between the facts found and the choice made. *Motor Vehicles Manufactures Association v. State Farm Mutual Automobile Ins. Co.*, 463 U.S. 29, 43 (1983).

Where a trade off between features is required to produce an invention from a combination of references, motivation to combine requires that the tradeoff be desirable not just feasible. See *Winter International Royalty Corp. v. Wang*, 53 U.S.P.Q.2d 1580 (Fed. Cir. 2000).

It is improper to apply an obviousness to try standard or indulge in hindsight evaluation or reconstruction. See *Ecolchem, Inc. v. Southern California Edison Co.*, 56 U.S.P.Q.2d 1065 (Fed. Cir. 2000).

It has been held that supporting a rejection on common knowledge and common sense is inappropriate. Reference to common knowledge without evidence in support or explanation in support is inappropriate. See *Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc.*, 51 U.S.P.Q.2d 1415, 1421 (Fed. Cir. 1999). Failure to articulate an appropriate reason for the

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rejection is fatal to the position of obviousness. The Patent Office cannot merely make conclusory statements when dealing with particular combinations of prior art but must set forth the rationale on which it relies. *In Re Sang Su Lee, supra*. Thus, it is improper to state a combination is within ordinary skill in the art without the required support.

An appropriate analysis in the determination of obviousness may not indulge in the forbidden hindsight evaluation. "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. *In Re Dimbiczak* 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). It has also been held that teachings of references can be combined only if there is some suggestion or incentive to do so. See *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

Reasoned findings are critical to the performance of an agency's functions and judicial reliance on agency findings. Absent reasoned findings based on substantial evidence, effective review would become lost in the haze of so called expertise. See *Baltimore and Ohio Railroad Co., v. Aberdeen & Rockfish Railroad Co.*, 393 U.S. 87, 91-92 (1968).

Other important considerations in the determination of obviousness is who is one of ordinary skill in the art and what is the level of ordinary skill in the art. One cannot determine if an invention would have been obvious to one of ordinary skill in the art without determining who that person would be. Several factors are evaluated to determine the level of ordinary skill. Those factors include: 1) the types of problems encountered in the art; 2) the prior art solution to

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those problems; 3) the rapidity of innovation; 4) the sophistication of the technology; and 5) the educational level of active workers in the field. See *Ruiz v. A. B. Chance Co.*, 57 U.S.P.Q.2d 1162 (Fed. Cir. 2000).

In accord with the Examiner's request, claim 26 has been amended to delete one of the words "comprising". Applicant apologizes for the redundancy.

Claims 3, 4, 6 and 14 stand rejected under 35 U.S.C. §112. These claims have been amended to address the Examiner's concerns. It is respectfully requested that these claims, as amended, be reviewed and that the rejection under 35 U.S.C. §112 second paragraph be reconsidered and withdrawn.

Claims 1-5, 8-13 and 18 stand rejected under 35 U.S.C. §102(b) as being anticipated by *Ballard et al.* (5,111,680). Claims 4-5, 8-13 and 18 depend directly or indirectly from claim 1. Claim 1 has been amended to clearly distinguish claim 1 and its depending claims from *Ballard et al.* Claim 1 now specifies that the vehicle platform have an underside and that the carriage track is downwardly opening and is positioned on the underside of the vehicle platform and that the carriage assembly is positioned on the underside of the platform. *Ballard et al.* does not disclose each and every limitation now defined in claim 1 and in particular those added by amendment and thus, the 102 rejection has been overcome. The other claims have been amended to provide the proper antecedent basis and to provide more clarity in the depending claims. *Ballard et al.* does not have a track on the underside. In fact, the track projects from the inside and outside edges of the platform and portions of the carriage are actually positioned

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above the track and extend from the side edge of the platform. Additionally, *Ballard, et al.* do not have a downwardly opening carriage track. At best, it might have a sideways opening carriage track. It is respectfully requested that the rejection of the claims under 35 U.S.C. §102(b) be reconsidered and withdrawn.

A review of Bustos and Smith indicates that there is absolutely no teaching, motivation or suggestion within those references to combine them in support of obviousness and no rational has been provided to support their combination. Because of that, the obviousness rejection must fail. Also, there has been no finding as to what is the level of ordinary skill in the art and there has been no discussion of objective considerations of non-obviousness as required and therefore the obviousness rejection must also fail. All that has been provided is a mere conclusion of obviousness. Most notably, the dictates of *Winter International Royalty Corp., supra*, have not been followed in this rejection. The only contention is that it would be feasible to combine the two references which is not acceptable. In fact it is not even desirable. The only way to come to the invention is through the teaching of the present invention and the use of prohibited hindsight. See *Ecolochem* above. No discussion is provided why it would be desirable to or why one would be motivated to combine the references which discussion is respectfully requested.

Claims 6, 7 and 14-17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Ballard, et al.* The Examiner recites structure taught by *Ballard, et al.* and then concludes “*Ballard* lacks a “pin biasing member.” However, given *Ballard’s* pin is clearly “biased” by gravity to remain locked in the aperture and since the applicant has not disclose that the use of a

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particular biasing member is for any particular purpose or is critical to solving any stated problem, this limitation is deemed an obvious matter of design choice.” This statement in support of obviousness is not a proper or sanctioned test for determining obviousness. Further, as stated above in the discussion of case law on obviousness, it is the duty of the Patent Office to explain the reason for why an invention is obvious. Mere conclusions will not suffice. In this case there is only a mere conclusion. And in fact, *Ballard, et al*, as the Examiner points out, does not have a pin biasing member. Without an explanation, as to why it would be obvious to provide one, this rejection must fail. The fact that gravity exists and biases certain things is not adequate in the eyes of the law particularly since gravity is not part of the defined invention. Further, as discussed above, *Ballard, et al*. do not teach the limitations as expressed in claim 1 from which claims 6, 7 and 14-17 depend. The amended claims provide structure that is not obvious over *Ballard, et al* and for this reason the amended claims distinguish over *Ballard, et al*. *Ballard, et al*. will not support a 35 U.S.C. §103(a) rejection. Additionally, there are limitations in the rejected claims that have not been addressed. For example, the coaxial orientation of a lock pin and pivot axis as defined in claim 7, the bottom deck having the carriage track mounted thereon and having a plurality of pin lock apertures as defined in claim 15, the release cable and other structure in claim 16 and the use of a compression spring as a biasing member as defined in claim 17. These limitations have not been discussed in the rejection and therefore the rejection of these claims must also fail for this reason. Applicant respectfully

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requests consideration of all the elements in claims 6-7 and 14-17. Because claims 6-7 and 14-17 depend from allowable amended claim 1 they are also allowable.

Claims 22-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Smith* (4,530,232) in view of *Barton* (4,520,649). The Examiner correctly acknowledges that *Smith* has a mounting assembly, an elongated tower arm and a pulling tower but that *Smith* lacks a force arm with a fixed end and a free end. The Examiner then cites to *Barton* for showing the use of inclined braces and concludes that it would be obvious to use the inclined braces of *Barton* to make up for the missing force arm in *Smith*. It is again respectfully pointed out that the basis for the rejection is merely conclusory and will not suffice as discussed above in the section on the law of obviousness. For this reason this rejection must fail. Additionally though, it is submitted that *Barton* is directed to a vehicle anchoring stand which presents different problems than the stabilization of a pulling tower arm and locking it in place relative to the platform for use. There is no suggestion in *Barton* and *Smith* of the defined force arm of claim 20 even if *Barton* is correctly combinable with *Smith*. Claim 22 specifically requires that the force arm include a substantially fixed end attached to the pulling tower and a free end (not in *Barton*) operable to attach to the vehicle platform (not in *Barton*) at a selected one of the plurality of attachment locations of the vehicle platform (not in *Barton*). *Barton* discloses inclined braces, in fact a plurality of inclined braces positioned radially about a column structure and attached at an end to gussets which are part of the column structure and at the other end to the upright portion of the column structure. The braces are apparently used to resist the bending of the upright portion of

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the column structure during the application of force thereto. This in no way suggests the use of a force arm to stabilize a pulling tower by attachment to the vehicle platform and lock the pulling tower in place relative to the platform. The device of *Barton* is set in place on a platform using an aperture in the platform. In no way are the inclined braces attached to the platform and do not lock the column in place. Additionally, a careful reading of *Smith* shows that its towers 64 are reinforced to the pivot arm 63 through use of corner brace members 96. It would not be obvious to add an additional element, i.e., the defined arm, since *Smith* found the use of corner braces to be adequate. Thus, there is no problem of reinforcement or locking to be solved in the *Smith* structure. *Smith* uses a pin 91 to lock the pivot arms 63 in place. It would not be obvious therefore to add the defined arm since no problem is pointed out by *Smith* in its use of separate braces and locking pin. It is respectfully requested that rejection of claim 22 be reconsidered and withdrawn.

Regarding claim 23, the Patent Office has taken the position that *Smith* discloses that the entire assembly that carries the vehicle (i.e., the carriage assembly) pivots. The carriage assembly as used in claim 23 carries, as seen in the Figures, the pulling tower assembly. It is this carriage that moves relative to the platform allowing the pulling tower assembly to move. The *Smith* pivot allows the entire platform on which the car is mounted to move. These are two entirely different structures. Thus, the pivot of *Smith* will not support the rejection of claim 23 in its definition of a movable carriage assembly. Reconsideration of the rejection of claim 23 is respectfully requested.

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Regarding claim 24, it depends from claim 22 which is allowable and thus claim 24 is also allowable. Reconsideration withdrawal of this rejection is respectfully requested.

Claim 25 is also rejected over the combination of *Smith* and *Barton*. It is submitted that the rationale provided for the rejection does not meet the legal standards to properly support an obviousness rejection and therefore the rejection must fail. Additionally, claim 25 depends from claim 22 and because of the allowability of claim 22, claim 25 is also allowable.

Reconsideration and withdrawal of the rejection claim 25 is respectfully solicited.

Claims 26-29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Ballard, et al.*, in view of *Barton*.

It is again respectfully submitted that the rejection as stated is legally insufficient to support a 35 U.S.C. §103(a) rejection as discussed above in the legal section. There is absolutely no rationale provided for why it would be obvious to use the “force arm of *Barton* in the structure of *Ballard, et al.* In fact, the force arm, as defined in claim 26 and the claims depending therefrom, has one end attached to the tower and the other end attachable to the platform. As discussed above, *Barton* uses inclined braces that attach between the upright portion of the column structure and another part of the column structure. Those arguments hold for the rejection of claim 26. Thus, it is submitted that *Ballard, et al.* and *Barton* will not support an obviousness rejection of the force arm as defined in claim 26. It is respectfully requested that the rejection of claim 26 be reconsidered and withdrawn.

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Claims 27-29 have apparently been rejected over *Ballard, et al.* in view of *Barton* in that *Barton* teaches that the arm is adjustable, can pivot and has locking members. Again, it is respectfully pointed out that there is no rationale provided for the combination of references making this rejection legally deficient as discussed above. It is respectfully pointed out that claim 27 requires that the force arm be operable to pivot three dimensionally. This limitation was not discussed in the rejection as required. *Barton* does not appear to disclose three dimensional pivoting. Thus, the suggested combination of references will not support a rejection of claim 27. Reconsideration and withdrawal of the rejection of claim 27 is respectfully requested. Claim 28 depends from claim 26 which as discussed above is believed to be allowable and hence claim 28 is also allowable. Reconsideration and withdrawal of the rejection of claim 28 is respectfully solicited. Claim 29 defines a force arm comprising a pivoting platform lock configured for insertion in the platform anchoring apertures and for rotation to lock in the platform anchoring apertures. There is absolutely no disclosure in either *Barton* or *Ballard, et al.* of such a structure. In fact, these limitations have not been addressed in the rejection of claim 29. Thus, claim 29 is not obvious over *Ballard, et al.* in view of *Barton* and the rejection is deficient. Reconsideration and withdrawal of the rejection of claim 29 is respectfully solicited.

It is now believed that all of the pending claims in the present application, namely, claims 1-29 contain limitations and restrictions which patentably distinguish them over the cited prior art. None of the cited references, either alone or in any combination thereof disclose or suggest

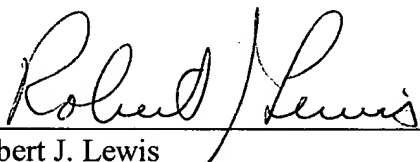
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the novel features associated with the present straightening bench as explained above, nor do the referenced constructions provide the specific advantages and objectives obtained by the present device. Favorable action and allowance of the claims is therefore respectfully requested.

If any issue regarding the allowability of any of the pending claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's amendment, or if the Examiner should have any questions regarding this amendment, it is respectfully requested that Examiner please telephone Applicants' undersigned attorney in this regard.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

Claim 1, 2, 3, 4, 6, 14, 15 and 26 have been amended as follows:

WHAT IS CLAIMED IS:

1. A vehicle straightening bench for applying force to vehicle chassis and restoring vehicle chassis to desired configurations, the bench comprising:
 - a vehicle platform including a front, a rear, opposed sides corresponding to a length, a top, and ~~a bottom~~ an underside, the vehicle platform being operable to support a vehicle chassis to be straightened;
 - at least one anchor attachable to the platform and operable to secure the vehicle chassis to the vehicle platform;
 - a downwardly opening carriage track ~~mounted~~ positioned on the underside of the vehicle platform and extending along the length of the vehicle platform;
 - a carriage assembly movably received by the carriage track and positioned on the underside of the platform; and
 - a pulling tower assembly mounted on the carriage assembly.
2. The bench according to claim 1 wherein the pulling tower assembly is pivotally mounted on the carriage assembly.
3. The bench according to claim 2 wherein the pulling tower assembly includes a pulling tower attached to a tower arm and the carriage assembly includes a pulling tower assembly positioning mechanism engaging at the tower arm, the tower arm extending between the pulling tower and the carriage assembly and mounting the pulling tower to

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the carriage assembly, the positioning mechanism being operable to hold the pulling tower in a transport position in which the tower arm is substantially perpendicular to the bench.

4. The bench according to claim 2 wherein the pulling tower assembly includes a pulling tower attached to a tower arm and the carriage assembly includes a tower positioning mechanism engaging the tower arm, the tower arm extending between the pulling tower and the carriage assembly and mounting the pulling tower to the carriage assembly, the positioning mechanism including a pawl follower slidably mounted on the tower arm and a notch plate mounted on the carriage assembly and defining a notch for receiving the pawl follower, so that the tower positioning mechanism holds the pulling tower in a transport position in which the tower arm is substantially perpendicular to the bench when the pawl follower is received in the notch.
6. The bench according to claim 5 wherein the carriage assembly includes a carriage body ~~defining~~having a lock pin opening ~~therein~~ and a locking mechanism comprising a lock pin movably received in the lock pin opening, a lock pin biasing member received in the lock pin opening and engaging the lock pin to bias the lock pin into an extended locking position in which an operator applying force to the pulling tower can overcome the force of the pawl biasing member to pivot the pulling tower relative to the carriage assembly.
14. The bench according to claim 1 wherein the carriage assembly includes a carriage body ~~defining~~having a lock pin opening therein and a locking mechanism comprising a lock pin movably received in the lock pin opening, a lock pin biasing member received in the lock pin opening and engaging the lock pin to bias the lock pin into an extended locking position.

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15. The bench according to claim 14 wherein the platform comprises a bottom deck having the carriage track mounted thereon and defining a plurality of pin lock apertures operable to receive the lock pin.
26. A vehicle straightening bench ~~comprising~~ for applying force to vehicle chassis and restore vehicle chassis to desired configurations, the bench comprising:
 - a vehicle platform including a front, a rear, opposed sides corresponding to a length, a top and a bottom, the vehicle platform being operable to support a vehicle chassis to be straightened, and the vehicle platform defining a plurality of anchoring apertures;
 - at least one anchor attachable to the platform and operable to secure the vehicle chassis to the platform;
 - a carriage track mounted on the platform and extending along the length of the platform;
 - a carriage assembly movably received by the carriage track;
 - an elongated tower arm having a mounting end attached to the carriage assembly and a distal end opposite the mounting end;
 - a pulling tower attached to the distal end of the tower arm; and
 - a force arm including a substantially fixed end attached to the pulling tower and a free end operable to attach to the vehicle platform at a selected one of a plurality of attachment locations.